

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicants: J. Boer et al.

Case: 6-2-2-5

Serial No.: 10/621,862

Filing Date: July 17, 2003

Art Unit: 2611

Examiner: Leila Malek

Title: Signal Quality Estimation in a
Wireless Communication System

REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request review of the final rejection, dated January 9, 2008, in which claims 1-34 and 36-38 were finally rejected under 35 U.S.C. §103(a). No amendments are being filed with this request. A Notice of Appeal is submitted concurrently herewith.

Applicants incorporate by reference herein all previous responses filed in the above-identified application, including the responses filed on January 31, 2007; July 7, 2007; December 13, 2007; and June 6, 2008.

In a response dated December 13, 2007, Applicants submitted a declaration of prior invention in accordance with 37 CFR 1.131. The declaration and the exhibits attached thereto evidence the conception and actual reduction to practice of an invention falling within the present independent claims at least as early as March 12, 2001, and is therefore effective to remove from consideration certain references relied upon in the present rejections of claims 1-34 and 36-38. On page 2, first paragraph, of the final Office Action, and on page 2, first paragraph, of the Advisory Action, the Examiner contends that the declaration filed on December 13, 2007, is ineffective to remove these references from consideration.

On page 2, second paragraph, of the Office Action and on page 2, second paragraph, of the Advisory Action, the Examiner states that the declaration was signed by three of the four inventors named on the present application and contends that Applicants have failed to submit sufficient evidence that diligent efforts were made to reach the fourth inventor, Ra'anan Gil.

On June 5, 2008, Applicants submitted an Attorney Affidavit and related exhibits which show that, despite diligent efforts on the part of Applicants and their attorneys, the fourth inventor was unable to be reached. The Attorney Affidavit was prepared by, and signed by, David E. Shifren, Reg. No. 59,329, who is an attorney of record in the present application. Mr. Shifren attested that he sent an electronic mail message to the inventors for whom Mr. Shifren had current contact information requesting current contact information for inventor Ra'anan Gil. Mr. Shifren received an electronic mail message including current contact information for Mr. Gil. Mr. Shifren sent five subsequent electronic mail communications to Mr. Gil. Despite there being no indication that these electronic mail messages were not received by Mr. Gil, Mr. Shifren never received any response from Mr. Gil.

On page 2, second paragraph, of the Advisory Action, the Examiner objects to the Attorney Affidavit under 37 CFR 1.47 and MPEP §§ 409.03(d) and 605.03. Specifically, the Examiner argues that "certified mail return receipts, and telegrams that support a finding that the non-signing inventor could not be found or reached should be made part of the statement. Applicants' representative does not show any proof that the un-signing inventor could not be reached at his last mailing address." (emphasis in original)

Applicants respectfully note that Mr. Gil's last known mailing address was in Israel. Applicants respectfully submit that, pursuant to the *Mailing Standards of the United States Postal Service* §503.3.3.2, available at http://pe.usps.gov/text/DMM300/503.htm#3_3_2, "Certified Mail may be addressed for delivery only in the United States and its territories and possessions, through APOs and FPOs, or through the United Nations Post Office, New York." As such, Applicants are incapable of providing the certified mail return receipts requested by the Examiner.

The Examiner appears to be relying on, and misquoting from, a portion of MPEP 409.03(d) which states "[c]opies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement." (emphasis supplied)

Nowhere does MPEP 409.03(d) state that certified mail return receipts are required in order to show diligence. Indeed, MPEP 409.03(d) specifically states that certified mail return

receipts are merely one example of documentary evidence which may be submitted in order to support a finding that the nonsigning inventor could not be found or reached; this documentary evidence may also include, for example, internet searches and/or cover letters of instructions.

Indeed, MPEP 409.03(d) does not require that any documentary evidence be submitted along with the statement of facts. See, e.g., MPEP 409.03(d)(II) (where a refusal of the inventor to sign the application papers is alleged, proof that a *bona fide* attempt was made to present a copy of the application papers to the nonsigning inventor for signature may be sufficient; when there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts.)

Applicants further note that the CFR and MPEP sections cited by the Examiner are applicable only to the initial filing of an application. All four inventors in the present application signed the Declaration originally filed with the application, and thus the sections of the CFR and MPEP cited by the Examiner are inapplicable to the Declaration of Prior Invention at issue. For example, MPEP 605.03 states that each applicant's mailing or post office address is required to be supplied on the oath or declaration.

Furthermore, Applicants are not relying on 37 CFR 1.47. Rather, Applicants are relying on *Ex parte Foster*, 1903 C.D. 213, 214, 105 O.G. 261 (Comm'r Pat. 1903) (cited in MPEP 715.04) ("The rule says that the inventor's affidavit will be sufficient; but it does not say that the fact may not be established in some other way. . . . The essential fact is priority of invention, and the Office may accept any satisfactory evidence of that fact. . . . Where the testimony of the inventor cannot be obtained, priority may in some cases be proved without his testimony"). Compare MPEP 715.04(I)(D) with MPEP 715.04(I)(C).

In the present case, Applicants respectfully submit that the Declaration signed by three of the four inventors, including the inventor who prepared the evidence relied upon in the Declaration, is sufficient to show actual reduction to practice even without the testimony of the fourth inventor.

On page 2, third paragraph, of the final Office Action, and on page 3, first paragraph, of the Advisory Action, the Examiner contends that the evidence "submitted is insufficient to establish a conception of the invention prior to the effective date" of the aforementioned references because the exhibits "fail to show some important features of the invention."

In the final Office Action on page 2, third paragraph, the Examiner gives as an example of such a feature that of “generating at least one reference field based, at least in part, on the at least one field in the received signal and on a channel estimation signal, the channel estimation signal being distinct from the received signal and representative of at least one characteristic of the wireless communication channel.”

As previously noted, this feature is explicitly described in Exhibit 1 of the Declaration at page 2, third paragraph (“This implementation first scales the incoming samples according to the amplitude estimate of the channel and the power droop to position them around the reference points.”) See also FIG. 1, showing the generation of a reference field based at least in part on SIGNAL-field (a field in the received signal) and amplitude_cor (a channel estimation signal distinct from the received signal and representative of at least one characteristic of the wireless communication channel).

In the Advisory Action on page 3, first paragraph, the Examiner gives as an example of such a feature that of “generating the signal quality estimate by measuring a difference between one or more constellation points associated with the at least one reference field and one or more corresponding points associated with the at least one field in the receiving signal.”

This feature is explicitly described in Exhibit 1 of the Declaration at page 2, second paragraph (“The idea behind the SQ indicator is measuring the Euclidean distance between the reference constellation points and the received constellation points. The closer the received constellation points are to the received constellation points the better SQ [sic].”)

It should be further noted that 37 CFR 1.131(b) states that, in order to antedate a reference, one must “establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.” (emphasis supplied)

Applicants respectfully submit that because Applicants have established actual reduction to practice prior to the effective date of the reference, Applicants need not establish conception. See also MPEP 715.07(III) (“The showing of facts must be sufficient to show . . . actual reduction to practice of the invention prior to the effective date of the reference; or conception of

the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent . . . reduction to practice.”)

Furthermore, MPEP 715.02 states:

The 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim . . . in the sense that the claim as a whole reads on it. *In re Tanczyn*, 347 F.2d 830, 146 USPQ 298 (CCPA 1965) . . .

Further, a 37 CFR 1.131 affidavit is not insufficient merely because it does not show the identical disclosure of the reference(s) or the identical subject matter involved in the activity relied upon. If the affidavit contains facts showing a completion of the invention commensurate with the extent of the invention as claimed is shown in the reference or activity, the affidavit or declaration is sufficient, whether or not it is a showing of the identical disclosure of the reference or the identical subject matter involved in the activity. See *In re Wakefield*, 422 F.2d 897, 164 USPQ 636 (CCPA 1970).

In view of the foregoing, Applicants respectfully submit that the Declaration of Prior Invention filed December 13, 2007, and the Attorney Affidavit filed June 5, 2008, are effective to overcome the present §103(a) rejections of claims 1-34 and 36-38, thereby placing the application in condition for allowance.

Respectfully submitted,



Date: July 1, 2008

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) Boer 6-2-2-5
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		First Named Inventor J. Boer et al.
		Art Unit 2611 Examiner Leila Malek

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record. **43,602**
Registration number _____

attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

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Typed or printed name

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Telephone number

July 1, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

<input type="checkbox"/>	*Total of _____ forms are submitted.
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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